

TTAB

12-05-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #77

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Baby Bjorn AB : BEFORE THE  
Trademark: MISCELLANEOUS DESIGN : TRADEMARK TRIAL  
Serial No: 75/751,554 : AND  
Attorney: Mary A. Moy : APPEAL BOARD  
Address: Ladas & Parry : ON APPEAL  
26 West 61<sup>st</sup> Street  
New York, NY 10023

**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant, Baby Bjorn AB, has appealed the examining attorney's refusal to register the applicant's proposed baby carrier configuration under §2(e)(5) of the Trademark Act of 1946 (as amended) (hereinafter "the Trademark Act"), 15 U.S.C. §1052(e)(5), and under §§ 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127.

**FACTS**

- On July 15, 1999, the applicant sought registration on the Principal Register for a proposed mark consisting of a configuration of a baby carrier in connection with "baby carriers" listed in International Class 18. The applicant filed its application based on use in commerce under §1(a) of the Trademark Act and simultaneously claimed priority under §44(d) thereof based on Swedish Trademark Application No. 99-00356.

**\*\*Please place on Upper Right Corner\*\***  
**\*\*of Response to Office Action ONLY.\*\***

Examining Attorney: ALTREE, NICHOLAS  
Serial Number: 75/751554

- On November 10, 1999, the examining attorney refused registration under §2(e)(5), which acts as a total bar to the registration of marks that comprise any matter that, as a whole, is functional. The examining attorney also refused registration under §§ 1, 2 and 45 because the configuration of the goods is not inherently distinctive.
- On May 10, 2000, the applicant responded by arguing that its proposed configuration mark is “only one of a myriad of alternative designs available to consumers” and that “Applicant’s one-piece kite-shaped flap design is unique in the market.” See Applicant’s May 10, 2003 Response, at pp. 2 and 4.
- On July 31, 2000, the examining attorney continued the functionality and non-distinctiveness refusals under §2(e)(5) and §§ 1, 2 and 45 respectively, and also required the applicant to submit information with respect to (1) relevant design or utility patents relating to the proposed configuration of the goods, (2) promotional materials relating to the configuration of the goods, (3) information about alternative designs for the goods, and (4) information about any non-functional features of the configuration.
- On January 31, 2001, the applicant amended the application to claim acquired distinctiveness under §2(f) of the Trademark Act based on more than five years of use of the proposed mark in commerce. The applicant stated that it is claiming distinctiveness in “the overall shape” of its baby carriers and in “the placement of two vertical, non-functional stripes on the front panel of the carrier.” See Applicant’s January 31, 2001 Response, at p. 2. The applicant also responded to the examining attorney’s requests for information, with one notable exception. The applicant did not

provide any information regarding relevant design or utility patents relating to the subject matter of the configuration.

- On March 20, 2001, the United States Supreme Court issued an opinion in the case of *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001). In that case, the Court held that “[a] utility patent is strong evidence that the features therein claimed are functional.” *Traffix*, 532 U.S. at 29.
- On May 31, 2001, the examining attorney again requested information regarding relevant design or utility patents relating to the subject matter of the configuration, and rejected the applicant’s amendment claiming acquired distinctiveness under §2(f) based on the total bar to registration under the §2(e)(5) refusal, which was continued.
- On November 30, 2001, the applicant responded by submitting copies of U.S. Patent Nos. 5,490,620 and 5,732,861, relating to “elements” of its baby carriers. The applicant stated in its response that “these patents relate specifically to the clasp and harness strap elements of the configuration mark and not to Applicant’s overall kite-shaped, three-panel flap design.” See Applicant’s November 30, 2001 Response, at p. 5. Earlier in its response, the applicant argued that the “combination of functional and non-functional features manifests an aesthetic identity separable from the underlying function of the baby carrier goods.” See Applicant’s Response, at p. 4. The applicant also submitted a certified copy of its home registration under §44(e) of the Trademark Act.
- On April 24, 2002, the examining attorney continued and made final the refusals to register the proposed configuration mark under §2(e)(5) and §§ 1, 2 and 45 of the Trademark Act. With respect to the refusal under §2(e)(5), the examining attorney

highlighted specific claims made by the applicant in its above-referenced utility patents relating to baby carriers. The examining attorney also highlighted specific utilitarian claims made about the applicant's baby carriers, including the "front flap" design, in the applicant's advertising and promotional materials, all or which are of record. With respect to the refusal under §§ 1, 2 and 45, the examining attorney argued that in the event the proposed mark is found to be non-functional as a whole, the applicant's claim of acquired distinctiveness is not supported by sufficient evidence.

- On October 24, 2002, the applicant timely filed a notice of appeal under 37 C.F.R. §2.142. The applicant also filed a request for reconsideration in which the applicant entered a slightly amended drawing page and description of the configuration, thereby more precisely matching the drawing page with the applicant's claims of distinctiveness made in earlier responses to Office actions. The applicant also submitted additional exhibits in support of its arguments that the configuration is not functional under §2(e)(5) (see "Volume 1"), and that it has acquired distinctiveness under §2(f) (see "Volume 2").
- On July 2, 2003, the examining attorney denied the applicant's request for reconsideration and maintained the final refusals under §2(e)(5) and §§ 1, 2 and 45, and on September 5, 2003, the applicant timely filed its appeal brief.

## ARGUMENT

### **The Configuration Is Not Separable From The Functions Performed By The Goods**

Despite the applicant's relatively lengthy arguments and voluminous exhibits, the issue presented in this case is straightforward. The issue in this case is whether the features of the applicant's proposed configuration mark are encompassed in the applicant's two utility patents of record. If they are, then by allowing the applicant's configuration to register, the examining attorney would effectively be permitting "an 'end run' around the strict requirements of utility patent law by giving equivalent rights to exclude." See *J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition* §7.64, 7-147 (4<sup>th</sup> ed. 2001). The functionality doctrine articulated in §2(e)(5) arises from an important public policy consideration -- namely, the need to accommodate trademark law to the requirements of patent law. As the Supreme Court stated in *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163-64 (1995):

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

That kind of potentially limitless extension of patent law, which is meant to grant exclusivity only for a limited time, is precisely what §2(e)(5) is meant to prevent. As the U.S. Court of Appeals for the Federal Circuit recently stated, the *de jure* functionality doctrine found in §2(e)(5), as distinguished from protectible *de facto* functionality, "means that the product has a particular shape because it works better in this shape."

*Valu Engineering, Inc. v. Rexnord Corp.*, 61 USPQ2d 1422, 1425 (Fed. Cir. 2002)

(citation and internal quotation marks omitted) (upholding the Board's finding that certain conveyor guard rail designs were *de jure* functionality).

Just prior to the *Valu Engineering* case, the Supreme Court, in the case of *Traffix Devices, Inc. v. Marketing Displays, Inc.*, addressed a factual situation very similar to this case and held that “[a] utility patent is strong evidence that the features therein claimed are functional.” 532 U.S. 23, 29 (2001). The Supreme Court went on to state that “[w]here the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, *for instance, by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.*” *Id.*, at 30 (emphasis added).

The applicant has attempted to address this requirement by claiming acquired distinctiveness in what it refers to as a “combination of functional and non-functional features” that “manifests an aesthetic identity separable from the underlying functions of the baby carrier goods.” *See* Applicant's October 24, 2002 Response, at p. 13. Interestingly, the applicant admits that its configuration includes functional features, although it elsewhere refers to its configuration as a “combination of arbitrary curves comprising its distinctive one-piece, kite-shaped flap design and distinctive front-panel stripes.” *Id.*, at p. 8. The fundamental flaw in the applicant's argument is that the so-called “arbitrary curves” and “kite-shaped flap” (i.e., the shape of the device) are integrally bound up in the functionality of the device, meaning that “the product has a particular shape because it works better in this shape.” *Valu Engineering*, 61 USPQ2d at 1425.

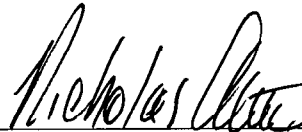
As the *Traffix* case made clear, in applying the “traditional rule” of functionality, the examining attorney need not consider each of the four *Morton-Norwich* factors, such as whether alternative designs are available, when an expired utility patent clearly indicates that a particular configuration is functional, as is the case here. *Traffix*, 532 U.S. at 33. As the examining attorney demonstrated in detail in the April 24, 2003 Office action, the highlighted claims found in the applicant’s Patent Nos. 5,490,620 and 5,732,861 reveal that the “kite-shaped” nature of the front flap is integral to how the goods functions.

Moreover, the applicant’s own advertising materials make several claims regarding the utilitarian advantages of the product design at issue. For example, it is the shape of the flap that (1) gives firm and comfortable support to the baby’s head and back, particularly when the baby is facing inward, (2) permits the child to sit comfortably and see adequately when facing outward by folding the top portion of the front flap down, (3) permits the mother to nurse in privacy without removing the baby because of the greater width of the front flap at the top, and (4) provides the baby with greater range of motion because of the recesses through which the baby’s arms extend. As the examining attorney stated when issuing the final refusal, these functional features “are essential to the use and purpose of the goods and affect their quality.” See April 24, 2002 Office action, at p. 4. The examining attorney has simply applied the “traditional rule” for functionality laid out by the Supreme Court in *Traffix*, that a product design is functional “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Traffix*, 121 S. Ct. at 1261.

## CONCLUSION

For the reasons presented above, the examining attorney believes that the applicant's proposed configuration mark comprises matter that, as a whole, is functional. The examining attorney believes that the Board need look no further than the Supreme Court's recent decision in the *Traffix* case and the applicant's two utility patents covering the essence of the configuration at issue here to reach the same conclusion. The refusals to register the applicant's proposed configuration mark under §2(e)(5) and §§ 1, 2 and 45 of the Trademark Act should be affirmed.

Respectfully submitted,



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